

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Catherine LIN-HENDELSer. No.: **09/544,036**Filed: **April 6, 2000**For: **MULTIPLE SELECTION OF DIGITALLY
STORED OBJECTS AND
CORRESPONDING LINK TOKENS FOR
SIMULTANEOUS PRESENTATION**Group Art Unit: **2179**Examiner: **Mylinh T. TRAN**Attorney File No.: **LH 001**Confirmation No.: **7503**

Examiner's Answer Mailed On:

April 2, 2007**REPLY BRIEF TO THE**
BOARD OF PATENT APPEALS AND INTERFERENCES

This Reply Brief is responsive to the Examiner's Answer mailed on April 2, 2007, in the above-referenced patent application. The Reply Brief is being filed within two months of the mailing date of the Examiner's Answer and therefore is timely. 37 C.F.R. § 41.41(a)(1). No fees are needed to file this Reply Brief. If the undersigned attorney is mistaken regarding the fees, authorization is hereby granted to charge to Deposit Account No. 50-3196 all fees necessary to file this Reply Brief.

Applicant-Appellant relies on the Appeal Brief for exposition of the grounds for reversal of the rejections, and takes this opportunity to respond to a number of arguments made in the Examiner's Answer, as well as to address certain issues and supplement arguments in view of the standard for determining obviousness pronounced by the Supreme Court in its recent opinion in *KSR*

Int'l Co. v. Teleflex Inc., 550 U.S. ___, 2007 U.S. LEXIS 4745 (2007). Applicant-Appellant intends the arguments in this Reply Brief to supplement the arguments made in the Appeal Brief, rather than to replace them.

I

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1. Claims 1, 7, 8, 12-24, 26, 27, 29, 31, 48, and 49 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Himmel *et al.*, U.S. Patent Number 6,211,874 (“Himmel” in this Reply Brief) in view of Gibson, U.S. Patent Number 6,313,854 (“Gibson” in this Reply Brief).

2. Claims 2-5, 32-34, and 40-43 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Himmel in view of Gibson, and further in view of Kaply, U.S. Patent Number 6,215,490 (“Kaply”).

3. Claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Himmel in view of Gibson and Kaply, and further in view of Gilman *et al.*, U.S. Patent Number 6,208,770 (“Gilman”).

4. Claims 9-11 and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Himmel in view of Gibson, and further in view of Iyengar *et al.*, U.S. Patent Number 6,360,205 (“Iyengar”).

5. Claims 25 and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Himmel in view of Gibson, and further in view of what the Final Office Action and the Examiner’s Answer asserted to be admitted prior art.

6. Claim 35 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Himmel in view of Gibson and Kaply, and further in view of Gavron *et al.*, How to Use Microsoft Windows NT 4 Workstation 105 (Ziff-Davis Press, 1996) (“Gavron”).

7. Claim 36 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Himmel in view of Gibson and Kaply, and further in view of Tang *et al.*, U.S. Patent Number 5,793,365 (“Tang”).

8. Claims 37-39 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Himmel in view of Gibson and Kaply, and further in view of Itoh, U.S. Patent Number 5,966,122 (“Itoh”).

9. Claim 44 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Himmel in view of Gibson and Kaply, and further in view of Moore *et al.*, U.S. Patent Number 6,330,575 (“Moore”).

10. Claim 45 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Himmel in view of Gibson and Kaply, and further in view of Collins-Rector *et al.*, U.S. Patent Number 6,188,398 (“Collins-Rector”).

11. Claim 46 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Himmel in view of Gibson and Kaply, and further in view of what the Final Office Action and the Examiner’s Answer asserted to be admitted prior art.

12. Claim 47 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Himmel in view of Gibson, Kaply, what the Final Office Action and the Examiner’s Answer asserted to be admitted prior art, and further in view of Iyengar.

II **ARGUMENT**

A. Declarations

In the Appeal Brief, we argued that the three Rule 131 Declarations submitted in this case establish that the invention as recited in independent claims 1 and 27 was reduced to practice before the effective date of the Himmel reference. (The effective date of the Gibson reference is later than the effective date of the Himmel reference; therefore, antedating Himmel also antedates Gibson.) In particular, we argued that Applicant's explanations of reduction to practice made in the three Rule 131 Declarations had not been considered. The response to these arguments in the Examiner's Answer implicitly acknowledges that at least the Third Rule 131 Declaration (dated February 27, 2006) has not been considered at all.

In responding to our arguments regarding the three Rule 131 Declarations, the Examiner's Answer (page 23) states that "Both Declarations and exhibits 12/18/03 and 09/30/04 under 37 CFR 1.131 have been considered but [are] ineffective to overcome the applied references." Note that this statement is silent regarding the Third Rule 131 Declaration of 2/27/2006.

Moreover, the Examiner's Answer asserts (pages 26-27) that there is no explanation of the exhibits or positive statements on the declaration to support the limitation of "simultaneously displaying together in a single window the retrieved destination objects for viewing." The quoted limitation, however, appears *verbatim* on lines 7-8 of page 2 of the Third Rule 131 Declaration. Clearly, the Third Rule 131 Declaration has not been considered.

The Examiner's Answer also asserts (page 27) that the Declarations do not support the limitation of "a single electronic webpage." The top paragraph of the Third Rule 131 Declaration

speaks of “a webpage” and “said webpage.”

The Examiner’s Answer further asserts (also on page 27) that the Declarations do not support “sub-framed” limitations. These limitations are not in issue at least with respect to independent claims 1, 27, and 48, because the claims do not recite them.

The Examiner’s Answer apparently accepts (page 24) that Applicant “put together a variety of mock-up data and programs in the same computer to demonstrate the base premise of the concept.” The Examiner’s Answer then states that the Applicant “did not know how to make the concept work from network to network and from website to website until 1999.” Independent claims, however, do not recite networking, and the claims therefore are not limited to networked embodiments.

It was error not to consider all the Declarations submitted in this case.

In considering patentability of independent claims 1, 27, and 48, it was error to require a showing of reduction to practice of embodiments with elements not recited in these claims.

B. Motivation to Combine

After filing of the Appeal Brief in this case, the Supreme Court announced its opinion in *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. _____, 2007 U.S. LEXIS 4745 (2007), holding that the teaching, suggestion, motivation (TSM) test of obviousness may not be applied in a rigid manner. Importantly, *KSR Int’l Co. v. Teleflex Inc.* does not dispose with the requirement for analysis of the references and for something beyond mere conclusions to justify a combination:

Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary

skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.

KSR Int'l Co. v. Teleflex Inc., slip opinion at 14. Indeed, in the very next sentence the Supreme Court stated that “[t]o facilitate review, this analysis should be made explicit.” *Id.* In requiring this “explicit analysis,” the Supreme Court quoted with approval the approach of the Court of Appeals for the Federal Circuit: “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.* (quoting *In re Kahn*, 441 F. 3d 977, 988, 78 U.S.P.Q.2D (BNA) 1329 (Fed. Cir. 2006)). The Supreme Court therefore left undisturbed the requirement that a “convincing line of reasoning supporting a rejection” must be presented. MPEP § 2144.

In the present case, the Examiner’s Answer enumerates (pages 27-28) the similarities in the respective subject matter of Himmel and Gibson. But the explanation of the reason to combine is the same as in the Final Office Action: “The motivation would have been to provide users more effectively manipulate and manage the viewable area of the browser while preserving the advantages of frames.” Examiner’s Answer at 28. There is no analysis, no balancing of advantages and disadvantages, nothing beyond a bare conclusory statement, which relies on the “advantages of frames.” There is no explanation of what is meant by “more effectively.” If this statement in the Examiner’s Answer and the corresponding statement in the Final Office Action mean that the advantages of the claimed apparatus and method would have provided the requisite motivation, then the purported motivation was taken from Applicant’s disclosure. Applicant’s disclosure, however, should not be used to make a *prima facie* case of obviousness. MPEP § 2143. If a different

justification for the motive to combine was intended, then some reasoning supporting the offered motivation should have been provided to make the *prima facie* case. “When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain why the combination of the teachings is proper.” MPEP § 2142

Moreover, even if Gibson discloses a plurality of sub-frames within a webpage, Gibson’s invention is intended for “displaying separate windows for respective frames, and enabling one or more window operations for each of the windows, such as resizing, minimizing, maximizing, and closing each of the windows.” Gibson, the Abstract (underlining added for emphasis). With respect to Figure 6 cited in the Final Office Action, Gibson states that it “is a pictorial representation of the creation of multiple child windows in a web browser wherein each child window corresponds to a respective frame defined by a web page,” Gibson, col. 5, lines 45-48 (emphasis provided). In fact, Gibson apparently teaches that frames within a webpage window are not desirable:

Frames are not child windows; that is, they are not resizable or otherwise controllable, since their attributes are fixed by the HTML coding. This aspect of frames can be very frustrating, because certain frames often take up so much of the web browser display area that other important frames are difficult to examine. In the example of FIG. 3, the web page has been constructed to provide one frame (17a) with a few control buttons or hypertext links to other pages at the web site, another frame (17b) having an advertisement, and the third frame (17c) containing the information which is of actual interest to the user. As a result, the viewable area assigned to frame 17c is considerably small, making the contents more difficult to read. This smaller presentation area can also make it more difficult to scroll through the frame using the scroll button. These difficulties are exacerbated when the parent browser window uses less than the full display area (i.e., the browser is in a restored state). Additionally, the advertisement in frame 17b might be presented with automated blinking, scrolling or highlighting which is very distracting, and can be particularly aggravating since that frame cannot be removed or reduced in size. Moreover, the web site may be designed such that the unwanted advertisement frame 17b persists even when other files are loaded into the other frames.

Older web browsers do not support frames,

Gibson, col. 4, lines 1-25.

In discussing all these disadvantages of having frames within a displayed webpage, Gibson apparently teaches away from displaying multiple sub-frames in a single webpage window. The Final Office Action and the Examiner's Answer should have considered this teaching away from the asserted combination, but did not.

It was error to combine the references without analysis and reasoning to support the resulting combination, and it was error not to consider Gibson's teaching away from the asserted combination.

C. Gibson Does Not Teach Display in a Single Window of Objects Associated With *Selected* Objects

In *KSR*, the Supreme Court also left undisturbed the requirement that the prior art references must teach or suggest all limitations of a claim. *See KSR Int'l Co. v. Teleflex Inc.*, slip opinion at 14. In the Appeal Brief, we argued that Gibson fails to teach display in a single window of objects associated with selected objects. (The Final Office Action acknowledged that Himmel does not disclose the plurality of stored objects displayed within a single window.) The Examiner's Answer responds to this argument (pages 28 and 29) with a page-long discussion of Himmel – not Gibson. Finally, the Examiner's Answer asserts without any explanation that “Gibson teaches a plurality of stored window objects 112a, 112b and 112c being displayed within a single window 114 (Gibson, figure 6).” This response utterly ignores the thrust of our argument: the limitations in issue require simultaneously displaying a plurality of destination objects each one of which is associated with a selected object. These limitations do not merely require simultaneously displaying in a single window a plurality of stored window objects.

According to claim 1,¹ each of the digitally stored objects is associated with a linked destination object. The means for retrieving retrieves and simultaneously displays a destination objects for each selected one of the plurality of the displayed digitally stored objects. Therefore, the retrieved and simultaneously displayed destination objects are associated with the objects displayed on the original webpage, and then selected from the original webpage.

According to the method of claim 27,² each of the selected digitally stored objects has a linked associated destination object. The method requires retrieving and simultaneously displaying the associated destination objects for each of the selected objects. Therefore, the retrieved and simultaneously displayed destination objects are associated with the objects originally displayed and selected.

Claim 48³ recites a computing device configured to display within a single window on the

¹ 1. A system for selecting and simultaneously displaying a plurality of digitally stored objects, comprising:
 means for displaying digitally stored objects via a webpage;
 means for selecting on said webpage a plurality of the displayed digitally stored objects, each displayed digitally stored object having at least one dynamically linked associated destination object; and
 means for retrieving the at least one dynamically linked destination object for each selected one of the plurality of the displayed digitally stored objects together from a storage medium and then simultaneously displaying together in a single window the retrieved destination objects for viewing.

² 27. A method for selecting and simultaneously displaying a plurality of digitally stored objects, comprising the steps of:
 displaying an array of digitally stored objects;
 selecting a plurality of digitally stored objects from the array of digitally stored objects, wherein each one of the selected plurality of digitally stored objects has at least one dynamically linked associated destination object;
 after the selecting step, retrieving the at least one dynamically linked destination object associated for each one of the selected plurality of digitally stored objects; and
 simultaneously displaying all together each one of the retrieved associated destination objects in a single window.

³ 48. A system for displaying information, the system comprising a computing device, the computing device comprising a display device and an input device, wherein the computing device is configured to:
 enable a user using the input device to select from a webpage displayed on the display device a plurality of objects, resulting in a plurality of selected objects, each of the selected objects being associated with a linked destination object;
 enable the user to submit the plurality of selected objects for processing;

display device the plurality of retrieved linked destination objects. The retrieved linked destination objects result from retrieving a linked destination object for each of the selected objects. The selected objects are selected by the user. Therefore, the retrieved and simultaneously displayed destination objects are associated with the objects originally displayed and then selected by the user.

In contrast, Gibson's Figure 6 "is a pictorial representation of the creation of multiple child windows in a web browser wherein each child window corresponds to a respective frame defined by a web page," Gibson, col. 5, lines 45-48 (underlining added for emphasis). Gibson's child windows shown in Figure 6 are thus defined by a web page, not selected by the user from the web page.

Gibson does not teach display in a single window of objects associated with selected objects.

retrieve a linked destination object for each of the selected objects, resulting in a plurality of retrieved linked destination objects; and
display within a single window on the display device the plurality of retrieved linked destination objects.

III
CONCLUSION

For the foregoing reasons as well as the reasons discussed in the Appeal Brief, Applicant-Appellant submits that all pending claims are patentable and respectfully requests reversal of the rejections.

Respectfully submitted,

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